

REMARKS

Discussion of Claim Amendments

Claims 20-22 have been amended to expedite prosecution, by reciting that the photosensitive resin composition (B) comprises a photoinitiator. No new matter has been added.

Discussion of Rejections

Claims 20-22 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable under Nojiri (U.S. Patent 6,329,111) in view of Taylor (U.S. Patent 5,371,148), Tanaka et al. (U.S. Patent 5,858,616), and Lipson et al. (U.S. Patent 4,239,849). Claims 20-22 are also rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Tanaka et al. in view of Taylor, Koike et al. (U.S. Patent 5,922,395), and Lipson et al.

Although Applicant disagrees with the rejections, Applicant has amended the claims. The cited references, either alone or in combination, fail to suggest to those of ordinary skill in the art the presently claimed invention.

Nojiri teaches that the resin composition layer also includes (c) a photoinitiator in order to aid in the photopolymerization. Thus, Nojiri requires that the resin composition layer is polymerized. Taylor teaches that reactive polymers may be photopolymerized either alone or with or without added photoinitiator; or the reactive polymers may be combined with radiation-polymerizable ethylenically unsaturated compounds (col. 7, lines 49-68). The focus or desired outcome is photopolymerization of layer (A). Taylor does not teach the use of a photopolymerization inhibitor alone (without an initiator or reactive groups) because that would produce a result diametrically opposite to Taylor's desired outcome. There won't be photopolymerization.

Nojiri and Taylor teach that the resin composition layer is photopolymerized. In contrast, as shown in the attached Declaration Under 37 C.F.R. 1.132, pages 3 and 4, the resin composition layer (A) is not photopolymerized. The amount of ethylenically unsaturated compound remains unchanged after irradiation. Nojiri and Taylor teach away from the present invention.

Tanaka et al. fails to cure the deficiency of Nojiri and Taylor. In Lipson et al., the amount of the polymerization inhibitor disclosed is an amount when the inhibitor is used in a composition along with the photoinitiator. Lipson et al.'s goal is to produce a photopolymerizable composition. However, as evident from the experimental results of the Rule 132 Declaration, if a photoinitiator is not used (as in one of Taylor et al.'s embodiments where an initiator is not used) and if 0.1 to 15 parts by weight of polymerization inhibitor is used, based on 100 parts by weight of the acrylic polymer, in the resin composition (A) layer of Nojiri and Tanaka et al., photopolymerization does not occur. Therefore, the combination of Nojiri et al. or Tanaka et al., (both requiring photopolymerization) in which the resin composition (A) layer is photosensitive, with Taylor et al. (without initiator but still polymerizing) and Lipson et al. (with initiator and inhibitor, still polymerizing) is inappropriate since the combination does not produce a system wherein resin layer is not photosensitive. There is no motivation, for example, to leave out the initiator but add a photoinhibitor.

As regards the second obviousness rejection (based on Tanaka et al. as the primary reference), Tanaka et al. discloses that the resin composition layer (A) contains an acrylic polymer, a fluorescent compound, an unsaturated compound, a polymerization inhibitor, and a photoinitiator. In Tanaka et al., the resin composition layer (A) is photosensitive in contrast to the presently claimed invention where it is not. Taylor, Koike et al., and Lipson et al. fail to cure the deficiency of Tanaka et al.

The presently claimed invention seeks to prevent photopolymerization of the resin composition (A) layer. The claims exclude the photopolymerization of layer (A). Further, the claims employ the term "consisting essentially of" in describing the resin composition layer (A).

The Office Action states that applicant's previously filed arguments are contradicted by the specification at page 8, line 23 to page 9, line 22. Applicant respectfully submits that there is no contradiction. The specification states that the photopolymerization initiator and/or the photo-polymerization assistant can be employed "if necessary" (page 8, line 25). This refers to an embodiment of the invention, not encompassed by the present claims.

The Office Action states: "Applicant argues that the present invention seeks to prevent photopolymerization of the resin composition layer (A) due to the migration of a



In re Appln. of Hiroaki SATOH
Application No. 09/271,447

photoinitiator from layer (B) into layer (A). This argument is unconvincing because it is not commensurate in scope with the claims, which do not require a photoinitiator in layer (B) and do not exclude the photopolymerization of layer (A)". Applicant has amended the claims to expressly recite that layer (B) comprises a photoinitiator. In addition, as discussed above, the claims exclude the photopolymerization of layer (A). Note, the claims employ the term "consisting essentially of" in describing the resin composition layer (A). Thus, the composition excludes anything that would materially affect the basic and novel characteristics of the invention.

In view of all of the foregoing, the obviousness rejections should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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